

REMARKS

Reconsideration of this Application is respectfully requested. Claims 1, 3, 11 and 12 are cancelled and Claims 2, 4-10 and 13-15 are amended, collectively, without prejudice or disclaimer. Claims 2, 4-10 and 13-15 remain in this case.

Applicant submits this Amendment And Response To Notice Of Non-Compliant Amendment, pursuant to a Notice Of Non-Compliant Amendment dated November 12, 2009. In response to the Notice Of Non-Compliant Amendment, Claim 5 is now provided with the Claim identifier - - previously presented - - rather than "currently amended". Applicant respectfully notes, however, that the Notice erroneously indicates that Applicant's Claim identifier for Claim 6 improper. Claim 6 is clearly amended by Applicant and, hence, the Claim identifier used, namely, "currently amended" is, indeed, accurate. Withdrawal of the subject Notice Of Non-Compliant Amendment, in this respect, is therefore respectfully requested.

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Initially in the Office Action, the Examiner rejected Claims 1-15 under 35 U.S.C. § 112, First Paragraph, on grounds of non-enablement. More particularly, while Examiner acknowledges that the Specification is enabling for including elemental sulphur, he takes the position that it does not reasonably provide enablement for a "compound" capable of liberating elemental sulphur. He explains that the Specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention, as disclosed, commensurate in scope with the Claims. In this connection, he believes that the nature of the invention involves application of an

elemental sulphur compound with polymer binders to provide treatment of textiles for a user's foot.

The Examiner goes on to assert that, although the Claims, as written, require "a compound capable of liberating elemental sulphur", the state of the "prior art", he says, is silent as to various "compounds" capable of being utilized in such a manner. Moreover, while the [degree of] skill in the art, he purports, is relatively high, he states that the Claims require liberating elemental sulphur from the compound which, he asserts, is a highly exact science with little predictability. In addition, the Examiner continues, even though the Specification "clearly" describes with sufficient specificity the application of elemental sulphur with polymer binder functions, as claimed, he alleges that it fails to include any "working examples" or direction as to a representative number of Species of the seemingly infinite number of possible compounds that, he says, [are] capable of "liberating elemental sulphur" when utilized in the manner claimed (i.e., on fabric with a polymeric binder), that would result in proper and predictable results without undue experimentation. Such "undue experimentation", he concludes, would necessarily encompass determining which compounds, selected again from a seemingly infinite number of compounds, would successfully liberate elemental sulphur when used on a fabric with a polymeric binder, as purportedly required by the present Claims. (citation omitted).

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In response, however, Applicant respectfully disagrees that Applicant's Specification is non-enabling. Indeed, we submit, from the outset there is apparently confusion between *compositions* capable of releasing elemental sulphur, on the one hand, and

compounds of sulphur, on the other hand, i.e., where other elements are bonded chemically with elemental sulphur such that there is no capability of releasing elemental sulphur in the sense of Applicant's invention. Applicant's Claims are thus amended to delineate a - - composition - - or a - - mixture - - rather than a "compound", to better define the invention without limiting effect.

With regard to the Examiner's indication that the Specification does not reasonably provide enablement for a compound capable of liberating elemental sulphur, Applicant states, and the Specification confirms, not only that the present invention utilizes "elemental sulphur, preferably in the micronized state" (see page 2, line 29 of the Specification), but also application of a "sulphur-based composition" (page 6, lines 17-18) *with examples* such as elemental sulphur "mixed with the glue employed for fixing the textile lining to the base material (generally a polyurethane) of the insole" (page 6, lines 22-25), a "deodorizing cream" made by amalgamating elemental sulphur (page 6, lines 26-28), and a substance having an elemental sulphur base and "vas[o]line or lanoline in proportions appropriate for obtaining the required density and homogeneity" (page 6, lines 28-31). Such disclosures and corresponding methods of "mixing" and "amalgamating" so as to provide the compositions indicated, we respectfully submit, are well-known by those skilled in the art and further description is unnecessary for purposes of illustrating the present invention.

Also contrary to the Examiner's assertions, in addition to the examples provided above, the Specification specifically recites, as an example, a composition 3% by weight elemental sulphur mixed with vasoline and lanoline in equal percentages (see page 6, line 31 - page 7, line 1).

Accordingly, Applicant respectfully disagrees that the Specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention, as disclosed, commensurate in scope with the Claims. Nor would there be any “undue experimentation”, we submit, that would necessarily encompass determining which compounds, purportedly selected from a seemingly infinite number of compounds, would successfully liberate elemental sulphur when used on a fabric with a polymeric binder, as allegedly required by the present Claims. To the contrary, Applicant’s Specification delineates compositions such as mixtures of elemental sulphur in a micronized state with compounds that are - - capable of liberating elemental sulphur - -.

Withdrawal of the Examiner rejection under § 112, First Paragraph, is therefore respectfully requested.

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Next, the Examiner rejected Claims 10-11 and 15 under 35 U.S.C. § 102(b) as allegedly anticipated by McCarter, U.S. Patent No. 4,260,660. Briefly, the Examiner argues that McCarter discloses each and every element of the Claims, namely, a composition comprising sulphur and acrylic latex, and a textile impregnated or treated with the composition (the Examiner making reference, in this regard, to the “examples” in McCarter).

The Examiner then rejected claims 1-3, 6 and 8 under 35 U.S.C. § 103(a) as purportedly being obvious and, therefore, unpatentable over the Japanese Reference, JP 9285483, in view of Tabata et al., U.S. Patent No. 6,077,794, and McCarter. According to the Examiner, the Japanese Reference discloses a textile associated with a user’s foot, and blending fibers with “a” sulphur as an active ingredient having high antibacterial effect

that controls athletes foot (the Examiner citing to the Abstract). The Examiner admits that the Japanese Reference fails to describe impregnating the fabric with a sulphur composition containing resin. He then looks to the teachings of Tabata et al. as purportedly disclosing known methods for deodorizing fabric including blending a deodorizing material into the fibers or attaching the sulphur to the surface of the fabric using a resin binder (the Examiner making reference to column 1, lines 20-35).

The Examiner further takes the position that McCarter discloses a known and suitable technique for attaching sulphur to the surface of a fabric material including impregnation of sulphur powder and acrylic type resin. Therefore, he concludes, taking the cited references collectively, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to modify the teachings of the Japanese Reference to have deposited the sulphur via coating the fabric, as allegedly suggested by Tabata et al., using the technique, purportedly set forth by McCarter, “with a reasonable expectation of predictable results” because, says the Examiner, Tabata et al. disclose that coating fibers with deodorizers is known in the art and since McCarter purportedly teaches a known and suitable method for attaching sulphur to the surface of fabric.

As for the alleged requirement of “releasing over time”, this, the Examiner says, is “clearly inherent” in the process because of his finding that the cited references render obvious each and every step of the claimed invention, including use of an acrylic latex binder and elemental sulphur compound and, thus, the results obtained by way of the cited references must necessarily be the same as tho[se] obtained by Applicant, unless Applicant is using other process steps that are not presently claimed.

With respect to Claims 2 and 3, the Examiner takes the position not only that McCarter discloses the limitations of these Claims (the Examiner explaining by reference to the “examples”), but also that a process using such features would have been obvious for the reasons set forth above.

Regarding Claim 6, while the Examiner believes that McCarter discloses a known and suitable technique for attaching sulphur to the surface of a fabric material including impregnation of sulphur powder and acrylic type resin, he acknowledges that this reference does not disclose the concentration of the ingredients. However, the Examiner asserts, the concentration of the binder and sulphur is a known “result effective variable”, directly effecting treatment of the fabric and binding properties. On this basis, he concludes that it would have been obvious to one of ordinary skill in the art to have determined the appropriate and optimal concentration of sulphur and resin with a “reasonable expectation of successful results”. The Examiner also finds that it would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to determine the optimum values of such concentration since, he says, it has been held that discovering an optimum value of a “result effective variable” involves only routine skill in the art. (citation omitted).

As to Claim 8, the Examiner comments that the polymer (it appearing that the Examiner is referring again to McCarter) is an acrylic-latex resin which, as allegedly evidenced by Applicant’s Specification, is “a selected adhesive utilized for assembling a shoe or part thereof”, whereas the Claim, he asserts, fails to require a shoe or part thereof.

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Thereafter, the Examiner rejected Claim 13 under 35 U.S.C. § 103(a) as allegedly obvious and, therefore, unpatentable over McCarter. The Examiner reiterates his belief that McCarter discloses a known and suitable technique for attaching sulphur to the surface of a fabric material including impregnation of sulphur powder and an acrylic type resin. He then acknowledges that the reference fails to disclose the concentration of the ingredients. However, he says, as before, that the concentration of the binder and sulphur is a known “result effective variable”, directly effecting treatment of the fabric and the binding properties. Therefore, he finds that it would have been obvious to one of ordinary skill in the art to have determined the appropriate and optimal concentration of sulphur and resin with a reasonable expectation of successful results. Additionally, the Examiner determines that it would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to determine the optimum values for the concentrations, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. (citation omitted).

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Finally, the Examiner has rejected Claim 15 under 35 U.S.C. § 103(a) as being obvious and, thus, unpatentable Ewing et al. (an alleged publication entitled “Sulphur Impregnated Clothing To Protect Against Chiggers”) in view of Tabata et al. and McCarter. More specifically, the Examiner takes the position that Ewing et al. teach a textile associated with a user’s foot and blending the fibers with “a” sulphur as an active ingredient (the Examiner making reference to the Abstract of Ewing et al.). The Examiner admits that Ewing et al. omit to disclose impregnating the fabric with a sulphur composition containing resin. He then looks to Tabata et al. for the purported teaching

that known methods for deodorizing fabric include blending the deodorizing material into the fibers or attaching the sulphur to the surface of the fabric using a resin binder (citing Column 1, lines 20-35).

The Examiner repeats his assertion that McCarter discloses that a known and suitable technique for attaching sulphur to the surface of a fabric material includes impregnation of sulphur powder and acrylic type resin. Thus, he reasons, taking the references collectively, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified Ewing et al. to include depositing the sulphur by coating the fabric, as allegedly suggested by Tabata et al., using the technique, as purportedly taught by McCarter, with a “reasonable expectation of predictable results”. According to the Examiner, there is such an expectation since Tabata et al. discloses that coating fibers with deodorizers is known in the art, and because McCarter describes a known and suitable method of attaching sulphur to the surface of fabric.

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Applicant, however, respectfully disagrees with the Examiner’s reading and application of the cited references.

Indeed, we submit, none of the cited references, whether taken alone or in any combination, disclose or suggest an article or a method having and utilizing the particular constituents and concentrations disclosed, namely: a polymeric binder of a selected acrylic, silicone, butadiene or polyurethane resin; a selected silicon resin at a concentration between about 10 and about 20 g/l; and use of an aqueous bath containing elemental sulphur generally within a range of 0.3 and about 1.0 g/l, a selected cationic surfactant at a

concentration between about 10 and about 20 g/l, and a selected softener generally within a range of 2 and 5 g/l.

Applicant respectfully disputes the Examiner's contention that the subject constituents and concentrations are a "known result effective variable". Indeed, Applicant does not state, nor does he suggest, that his invention is merely an optimum concentration of sulphur and resin.

Rather, Applicant's invention represents a major advance in odor suppression that combines particular constituents at specific, unique concentrations with a new methodology that not only achieves stable adherence of elemental sulphur to textile and/or footwear articles, but also for its gradual, time-release - for lasting, highly effective odor suppression.

Regarding the Examiner's indication that the foregoing is "clearly inherent" in Applicant's process and that the subject invention amounts merely to the combination of a synthetic binder with elemental sulphur, we respectfully submit, is erroneous as it is contrary to what is set forth in Applicant's Claims.

Notwithstanding the foregoing, Applicant has amended the Claims, without prejudice or disclaimer, to better define the invention. More specifically, method Claim 4, which was not rejected previously on substantive grounds, has been placed in independent form to include all of the general limitations of Claims 1 and 3. Claims 2 and 5-9 are, in turn, amended to depend from Claim 4 rather than Claim 1.

Similarly, composition Claim 10, which is analogous to Claim 1, has been amended to include the limitations generally of Claims 11 and 12, which are like those of Claims 3

and 4. Claims 13 and 15 are amended in a similar fashion to Claims 4 and 10, Claims 1, 3, 11 and 12 being cancelled, also without prejudice or disclaimer.

Accordingly, Claims 2, 4, 5-10 and 13-25, as amended, are believed to be in condition for allowance.

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The Specification and the Claims are amended to further comport with U.S. practice and, in so doing, to better define the invention without limiting effect, for clarity, consistency, and as a matter of desired style.

Applicant respectfully submits that none of the cited references, whether taken alone or in any combination, disclose or suggest Applicant's invention, as claimed. Withdrawal of the Examiner's rejections under §§ 102(b) and 103(a) is, therefore, respectfully requested.

Applicant has made a good faith attempt to place this Application in condition for allowance. Favorable action is requested. If there is any further point requiring attention

prior to allowance, the Examiner is asked to contact Applicants' counsel at (646) 265-1468.

Respectfully submitted,



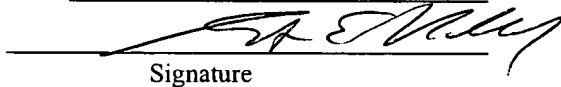
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